



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,958	01/15/2002	Takeshi Imaura	JP920000330US1	5188
23389	7590	08/22/2005	EXAMINER	
SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530			ZHEN, WEI Y	
			ART UNIT	PAPER NUMBER
			2191	

DATE MAILED: 08/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/047,958

Applicant(s)

IMAURA, TAKESHI

Examiner

Wei Y. Zhen

Art Unit

2191

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-28 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

3.0 9

Art Unit: 2191

1. This office action is in response to the amendment filed on 6/8/2005.
2. Claims 1-28 are pending (note that claims 3, 5, 10 are amended either to correct minor informality or to provide proper antecedent basis to overcome claim object or 35 U.S.C. 112, 2nd rejections, the amendments do not change the scope of these claims and the previous rejections still applied. See the previous office action mailed on 2/24/2005 for rejections to these claims. The objection to claim 3 and the rejections to claims 5 and 10 under 35 USC 112 2nd paragraph are withdrawn in view of applicant's amendment).
3. The rejections to claims 5, 10 under 35 USC 112 2nd paragraph are withdrawn in view of applicant's amendment.
4. The rejections to claims 23-28 under 35 USC 112, second paragraph and 35 USC 101 as being directed to non-statutory subject matter are withdrawn in view of applicant's arguments.

Response to Arguments

5. Applicant's arguments filed 5/24/2005 have been fully considered but they are not persuasive.

In the remark, applicant has argued:

- 1) In the present invention, the conversion of XML into ASN.1 is executed by referring to a Document Type Definition (DTD) which is neither taught nor suggested in Imamura. That is, the steps shown in Figure 1 (set forth in Claim 1) and Figure 2 (set forth in Claim 6) are neither taught nor suggested in Imamura.

Examiner's response:

Art Unit: 2191

1) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the conversion of XML into ASN.1 is executed by referring to a Document Type Definition (DTD)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Note that claims recite "converting into ASN.1 abstract syntax type a grammar definition for defining the grammar of XML data" which is clearly taught by Imamura at p. 60, left column, "...the point is to ...enable not only conversion from ASN.1 data to XML documents but the inverse of it...generate the same ASN.1 data from the same XML documents...").

Applicant has argued:

2) with respect to the rejection of Claim 1, Imamura does not teach a parsing step to remove the XML content text of a syntactic element and subsequent compressing the contents of the syntactic element as set forth in Claim 1 for combination with an ASN.1 transfer syntax.

Examiner's response:

2) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *remove* the XML content text of a syntactic element) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Art Unit: 2191

Applicant has argued:

3) Imamura does not disclose the compression and combining steps or the decompressing and combining steps.

Examiner's response:

3) The claims broadly recite steps of compression and combining steps or the decompressing and combining steps. The Imamura reference clearly discloses these broadly claimed limitations at pp. 61-62 section 4.2 and pp. 62-63 section 5.2, specifically, the encoding (compressing) and decoding (decompressing) of the data.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Art Unit: 2191

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wei Y. Zhen whose telephone number is (571) 272-3708. The examiner can normally be reached on Monday-Friday, 8 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wei Zhen
8/15/2005


WEI Y. ZHEN
PRIMARY EXAMINER